



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of : Dollinger, H. et al
Serial No. : 09/981,025
Confirmation No. : 5630
Filed : 10/16/2001
For : Neurokinin Antagonists
Docket No. : 1/1154

) Art Unit: 1617
) Examiner: Wang, Shengjun

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450
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PETITION FROM REQUIREMENT FOR RESTRICTION 37 CFR 1.144

Sir:

Applicants hereby submit this petition to modify the restriction requirement regarding Claims 17-20 made in the above-identified patent application. Granting of this petition is respectfully requested.

The Commissioner is hereby authorized to charge \$130.00 under 1.17(h) and any additional fees or refund any fees to account number 02-2995.

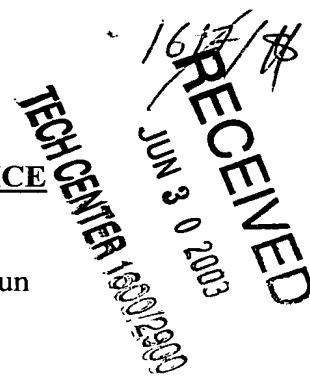
The restriction requirement dated 12/17/2002 had two groups:

- I. Claims 1-27 drawn to compounds, processes of preparing and compositions thereof. One classification was provided by the examiner: Class 514/315.
- II. Claims 28-31 drawn to methods of using the compounds, classified in Class 514/315.

Applicants responded in the paper dated 1/21/2003, electing with traverse and therefore preserving the right to file this petition. Applicants further properly requested rejoinder of the method claims of Group II with the examination of the compound claims of Group I in the event that the compound claims are determined to be patentable, since the method claims depend from the compound claims.

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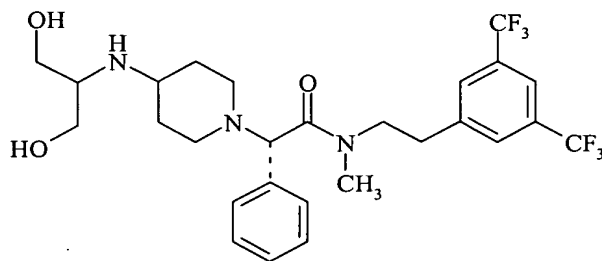
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The restriction requirement further required an election of a single species. The Election of Species requirement requires an election of a single disclosed species and an identification of the claims readable thereon.

In response, Applicant elected the compound disclosed in Example 2 at page 15:

N-[2-(3,5-bis-trifluoromethyl-phenyl)-ethyl]-2-[4-(2-hydroxy-1-hydroxymethyl-ethylamino)-piperidin-1-yl]-N-methyl-2-phenylacetamide having the structural formula:



For the elected species, Claims 1-16 and 21-31 read upon this compound, its method of preparation, a pharmaceutical composition thereof or its method of use.

The USPTO's Markush Practice is set forth at MPEP 803.02 . According to this practice, if the elected species is found to be patentable over the prior art, the search will be extended to the non-elected species to the extent necessary to determine the patentability of the Markush-type claim. Therefore, if the elected species is found patentable, it is proper to extend the search to non-elected species covered by the claims.

In the Office Action dated 4/4/2003, on page 2, paragraph 2, the Examiner has stated "The elected species was found allowable; the search has been extended to non-elected species (changing R1 and R2 in the elected compound). The claims have been examined insofar as they read on searched species."

The nonelected species, are the remainder of the species in claim 25. Therefore, according to the statement above by the examiner, R1 and R2 have been extended as follows:

R1: cyclopropylmethyl, 2-hydroxyethyl, 1,3-dihydroxyprop-2-yl.

R2: hydrogen, methyl, 3-hydroxypropyl, 2-hydroxyethyl.

In the Office Action, same page, the Examiner had withdrawn claims 17-20, reproduced below:

17. A compound according to claim 1, wherein

R¹ denotes a cyclopropylmethyl group, and

R² denotes a hydrogen atom, a C₁-C₃-alkyl group or a 3-hydroxypropyl group.

18. A compound according to claim 2, wherein

R¹ denotes a cyclopropylmethyl group, and

R² denotes a hydrogen atom, a C₁-C₃-alkyl group or a 3-hydroxypropyl group.

19. A compound according to claim 3, wherein

R¹ denotes a cyclopropylmethyl group, and

R² denotes a hydrogen atom, a C₁-C₃-alkyl group or a 3-hydroxypropyl group.

20. A compound according to claim 4, wherein

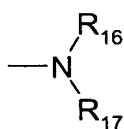
R¹ denotes a cyclopropylmethyl group, and

R² denotes a hydrogen atom, a C₁-C₃-alkyl group or a 3-hydroxypropyl group.

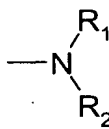
As can be seen from the claims, the difference between the claims and the scope of the examiner's search is that, for R2, the claims recite C₁-C₃-alkyl whereas the R2 in the species is methyl, i.e., C₁-alkyl. Applicants contend that the examiner did not follow the USPTO's Markush Practice is set forth at MPEP 803.02 . As stated above, if the elected

species is found patentable, it is proper to extend the search to non-elected species covered by the claims. According to the Examiner in the Office Action, Claims 1-16, 21-27 are pending. However, the examiner had stopped the search at the scope of the species claim 25, and for reasons that are unexplained, some of the generic claims (which embrace 17-20) remain in the case while 17-20 have been withdrawn.

Further, in the prior art rejection on page 3 of the Office Action, the document found in the examiner's search and used in the rejection (WO 97/32865 corresponding to US 6,498,162 enclosed herewith) shows at a corresponding molecular position to the present R2, a C₁₋₄ alkyl. See US 6,498,162. column 3, lines 18-38, wherein in the reference formula I, R7 is:



which corresponds to applicants



. Among the definitions of R16, R17 in the reference there is C₁₋₄alkyl. Hence, the reference discloses a scope of C₁₋₄alkyl while claims 17-20 recite C₁₋₃alkyl.

Accordingly, it can be clearly seen that the examiner's search has embraced subject matter that extends beyond methyl, and includes C1-3 alkyl as presently defined for R2 in claims 17-20.

By limiting the scope of the claims to R2 is methyl, the examiner is essentially asserting that expanding the search to ethyl and propyl would be an undue burden on the examiner. Applicants contend that first, as stated in the office action dated 12/17/2002, the claims have been classified all in one class/subclass: Class 514/315. Second, the prior art document cited by the examiner shown above further demonstrates that a search for compounds where R2 is methyl, and a search extended to methyl, ethyl, propyl (C₁-C₃-alkyl group), are coextensive and therefore not an undue burden on the examiner.

Also, Applicants would point out that if they are forced to file another divisional to cover R2 is ethyl, propyl, such divisional application would incur additional expense and a

shorter patent term than if all the claims were examined in this application together, and create additional administrative burdens on the Patent Office.

In short, the burdens placed on Applicants by this restriction requirement are very great whereas there is no undue search burden placed upon the Examiner considering that the search evidenced by the cited prior art demonstrates that his search has already extended beyond the withdrawn claims.

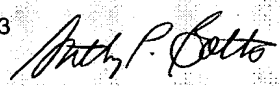
In view of the foregoing, Applicants respectfully request granting of this petition and requiring reinstatement of claims 17-20 in this patent application.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to:
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on June 20, 2003 
By: Anthony P. Bottino
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